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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/357,423  | 07/20/1999  | THOMAS M. BAER       | 17726-726           | 9233             |
| 34690   | 7590        | 02/25/2004           | EXAMINER            |                  |
| RIMAS T. LUKAS<br>PO BOX 3295<br>HALFMOON BAY, CA 94014 |             |                      | CROSS, LATOYA I     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1743                |                  |

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/357,423

Applicant(s)

BAER, THOMAS M.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11-20-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 5-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-37 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 25, 28 and 30 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 26, 27 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This Office Action is in response to Applicant's remarks filed on November 20, 2003.

Claims 1-37 are pending. Claims 5-24 are withdrawn from consideration. Applicants should note that in submitting a listing of the pending claims, Applicants are required to write out claims which are designated as "withdrawn".

#### *Withdrawal of Rejections from Previous Office Action*

- The rejection of claims 1-4, 26-28, 29, and 31-37 over Lipshutz et al is withdrawn in view of Applicants' arguments that the sample carrier of Lipshutz et al (needle) does not mate with a sample processing device to form a reaction chamber.
- The rejection of claims 1 and 25 over Fung et al is withdrawn in view of Applicants' arguments that the filing date of the reference is after Applicants' claimed priority date.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 25, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,277,648 to Colpan.

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Colpan teaches a method and device for isolating cell components. The device comprises a cylindrical hollow unit (40) which is equivalent to Applicants' claimed sample carrier because it contains a sample material and is adapted to mate with a sample processing device. In figure 1, the sample carrier is shown mating with a centrifuge tube, as recited in claim 25. In figures 3-6, the sample carrier is shown with an extraction unit (1), as recited in claim 2. With respect to claims 28 and 30, figures 3-8 also show dual chambers, one chamber having two ports (inlet and outlet) and the first chamber being connected to one of the ports. Although not shown in these figures, it is presumed that the extraction unit (1) connected to the sample carrier (40) can be attached to a vacuum processing device or centrifuge tube, as shown in figure 1 and as described in the examples.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 102(e) in view of the teachings of Colpan.

*Allowable Subject Matter*

3. Claims 31-37 are allowed.
4. Claims 3, 4, 25-27 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or suggest a device such as described in claim 1, where the sample processing device further includes a dilution chamber or a pump. The prior art of record also fails to teach or suggest such a device as a laminated assembly.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256.

The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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February 22, 2004

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700